

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DUANE A. LUNSFORD
and JIMMIE RAE BARAN, JR.

Appeal 2007-0006
Application 10/689,172
Technology Center 1700

Decided: April 30, 2007

Before EDWARD C. KIMLIN, THOMAS A. WALTZ, and PETER F.
KRATZ, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This case is not ripe for review and is, therefore, remanded to the Examiner for appropriate action. Appellants' invention is directed to an adhesive article (and method for preparing same) including a first primer layer consisting essentially of nanoparticles, which primer layer is interposed between a first adhesive layer and a substrate surface.

On May 08, 2006, the Appellants submitted a Brief, along with an Evidence Appendix containing a copy of a Declaration under 37 C.F.R. § 1.132 (2005) of Robert G. Murray. In the Brief, the Appellants present arguments against the Examiner's stated obviousness rejections that, in part, rely on the Declaration of Robert G. Murray (Br. 7). In addition, the Appellants rely on a European Patent (EP) Publication (EP 0 0372 756), as evidence, in support of a "teaching away" argument (Br. 7-9). This EP Publication (EP '756) was previously relied upon by the Examiner in rejecting Appellants' claims. *See Final Office Action 2-3.*

In the Examiner's Answer (showing a July 13, 2006 Mail Date), claims 1-11 and 29-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lange. Also, claims 6 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lange view of Melancon. The Examiner does not address the Declaration of Robert G. Murray in the Answer. The Examiner mentions the time Appellants spent in presenting arguments allegedly supported by EP '756; however, the Examiner furnishes no specific rejoinder. Rather, the Examiner dismissively discounts the value of the EP '756 evidence seemingly because the Examiner no longer applies EP '756 in rejecting the claims. This is clearly an improper basis for not considering and addressing the merits of Appellants' teaching away argument and evidence.

On July 20, 2006, Appellants submitted a Reply Brief noting, inter alia, the Examiner's alleged oversight and failure to fully address Appellants' arguments, allegedly supported by EP '756, as set forth in the Brief. The Reply Brief was entered and considered, without further

comment, by the Examiner as set forth in a Communication mailed September 11, 2006.

However, we additionally observe that Appellants' Brief is not technically in compliance with our Regulations. In this regard, 37 C.F.R. § 41.37 (c)(1)(ix) (2006) provides, in part, that the Brief must include a copy of any other evidence that the Appellants rely upon in the Briefs. A copy of EP '756 is not provided in the Evidence Appendix accompanying the Brief. Nor is a statement provided in the Evidence Appendix, which statement sets forth "where in the record that evidence was entered in the record by the Examiner." 37 C.F.R. 41.37(c)(1)(ix). In this regard, this latter required statement by Appellants is missing from the Evidence Appendix for both the Murray Declaration and EP '756.

In light of the above, we remand this application to the Examiner to:

1. Forward to Appellants a Notice of the defective Brief with respect to the Evidence Appendix omitted items noted above to afford Appellants an opportunity to correct these technical defects and comply with the Rule; and

2. Upon submission of a corrected Evidence Appendix for the Brief by Appellants in compliance with our Regulations, the Examiner should address Appellants' arguments in the Brief and Reply Brief and the relied upon evidence that is already of record in a Supplemental Answer, if the Examiner maintains the stated rejection. In so doing, the Examiner must explain why the relied upon evidence is not persuasive of a teaching away, a lack of suggestion for the proposed modification or a lack of a reasonable expectation of success for the proposed modification. The Examiner may

wish to take into account the depth, or lack of depth, of any of the evidence in support of Appellants' contentions vis-à-vis the teachings of Lange. This is especially the case given that Appellants are presumably in a better position than the PTO to explain why the EP '756 teachings of an alleged requirement for employing ambifunctional silane in the primer should outweigh the predictive and suggestive value of the experimental test(s) of Lange (the principal applied reference) establishing a good adhesive property for the adhesive layer to a substrate when using a primer (without an ambifunctional silane therein). We note that the assignee of record of the subject application appears to be the assignee of both EP '756 and Lange.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50 (a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board.

REMANDED

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